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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/409,376	09/30/1999	CHRISTOPHER SHANE CLAUSSEN	AT-9-99-480	5290

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LAW OFFICE OF JOSEPH R BURWELL
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EXAMINER

BIENEMAN, CHARLES A

ART UNIT

PAPER NUMBER

2176

DATE MAILED: 02/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/409,376

Applicant(s)

CLAUSSEN ET AL.

Examiner

Charles A. Bieneman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 9/30/99, 1999, 8/23/00, 2000, 8/24/02.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 September 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2 and 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

1. This action is responsive to the following communications: original application filed on September 30, 1999, Information Disclosure Statements filed on August 23, 2000, and September 24, 2002. and Formal Drawings filed on September 24, 2002.
2. Claims 1-20 are pending. Claims 1, 12, 15, and 17 are independent claims.

Information Disclosure Statement

3. The information disclosure statement filed August 23, 2000 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but some information referred to therein has not been considered, as indicated by the lines drawn through the references for which copies are missing.
4. One reference in the Information Disclosure Statement filed September 24, 2002 was not considered because its date of publication is after applicant's filing date, as indicated by the line drawn through the reference.

Drawings

5. The corrected or substitute drawings were received on September 24, 2002. These drawings are approved.

Specification

6. The specification is objected to because it contains a copyright notice that does not conform with 37 CFR 1.71, which provides in relevant part:

(d) A copyright or mask work notice may be placed in a design or utility patent application adjacent to copyright and mask work material contained therein. The notice may appear at any appropriate portion of the patent application disclosure.

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For notices in drawings, see § 1.84(s). The content of the notice must be limited to only those elements provided for by law. For example, "©1983 John Doe" (17 U.S.C. 401) and "*M* John Doe" (17 U.S.C. 909) would be properly limited and, under current statutes, legally sufficient notices of copyright and mask work, respectively. Inclusion of a copyright or mask work notice will be permitted only if the authorization language set forth in paragraph (e) of this section is included at the beginning (preferably as the first paragraph) of the specification.

(e) The authorization shall read as follows:

A portion of the disclosure of this patent document contains material which is subject to (copyright or mask work) protection. The (copyright or mask work) owner has no objection to the facsimile reproduction by any- one of the patent document or the patent disclosure, as it appears in the Patent and Trademark Office patent file or records, but otherwise reserves all (copyright or mask work) rights whatsoever.

Appropriate correction is required.

7. The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.

Claim Objections

8. The claims are objected to because the lines are crowded too closely together, making reading and entry of amendments difficult. Substitute claims with lines one and one-half or double spaced on good quality paper are required. See 37 CFR 1.52(b).

Claim Rejections - 35 USC § 112

9. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

10. **Claims 1-11 and 14-20** are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Independent claims 1, 14, 15, and 17 all recite generating executable code but

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applicants' disclosure only provides support for generating a particular species of executable code, a servlet. Page 5, line 7, page 10, lines 12 – page 11, line 9; page 12, line 16 – page 15, line 14.) The statement on page 11, lines 7-8 that the DOM is “interpreted to produce a Java object, such as a servlet” would not have been sufficient to have enabled a person skilled in the art to have practiced generation of a executable code in general because the disclosure only describes how to practice the claimed invention by generating and using a servlet.

The dependent claims not mentioned above are rejected for fully incorporating the deficiencies of their base claims.

11. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

12. **Claims 1-11 and 14-20** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Independent claims 1, 14, 15, and 17 all recite generating executable code but applicants' disclosure only describes generating a particular species of executable code, a servlet. Page 5, line 7, page 10, lines 12 – page 11, line 9; page 12, line 16 – page 15, line 14.) The claims are thus vague and indefinite because it is not clear what “executable code” encompasses apart from a servlet. The statement on page 11, lines 7-8 that the DOM is “interpreted to produce a Java object, such as a servlet” does not overcome this confusion because the disclosure only describes how to practice the claimed invention by generating and using a servlet.

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Further, **claim 14** is also rejected because the word "isolating" is a relative term and is vague and indefinite. The claim recites "isolating a given task" but it is not clear with respect to what the given task is to be isolated.

The dependent claims not mentioned above are rejected for fully incorporating the deficiencies of their base claims.

13. Claim 5 recites the limitation "the servlet" in line 1. There is insufficient antecedent basis for this limitation in the claim. It is noted that the limitation is not recited earlier in claim 5 nor is it recited in claim 1, from which claim 5 depends.

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

16. **Claims 1-2, 6-9, 11, 14-17, and 20** are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,125,391 to Meltzer et al., issued September 26, 2000, filed October 16, 1998, in view of Laurence Vanhelsuwé, *Mastering Java Beans* (Sybex: 1997).

Regarding **independent claim 1**, Meltzer et al. teaches replacing a tag in a DOM with a script. and processing the DOM to generate executable code having a call that is generated as a result of the script inasmuch as Meltzer et al. teach that “XML logic structures are translated into JAVA objects which carry the data of the XML element as well as methods associated with the data such as get and set functions.” (Meltzer et al., col. 26, lines 27-30; *see also* col. 28, lines 11-13: “One preferred version of the tree builder 506 generates a document object model DOM object 507, according to the specification of the W3C”.)

Meltzer et al. do not teach generating an object having a method for performing a given task. However, *Mastering Java Beans* teaches Java Beans as objects that have methods for performing a given task on pages 43-44. Moreover, *Mastering Java Beans* teaches on pages 33-34 that Java Beans have the benefits of offering reusable functionality and being platform-independent. Therefore, it would have been obvious to one of ordinary skill in the art to have generated Java Beans, *i.e.*, an object having a method for performing a given task.

Further, Meltzer et al. do not teach at request time having the call invoke the method in the object but this step would have been obvious to one of ordinary skill in the art in view of the benefits of calling methods in Java Beans taught by *Mastering Java Beans* and discussed above.

Regarding **dependent claim 2**, Meltzer et al. does not disclose that the object is a custom tagbean, but as noted above regarding claim it would have been obvious to one of ordinary skill in the art to have the object be a Java Bean, *i.e.*, a custom tagbean.

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Regarding **dependent claim 6**, Meltzer et al. and *Mastering Java Beans* do not disclose the object including error-handling code. However, notice is taken that use of error-handling code was well known in the art at the time of applicants' claimed invention, and that it was well known that using error-handling code had the benefit of providing a more robust and stable application. Therefore, it would have been obvious to one of ordinary skill in the art to have the object include error-handling code.

Regarding **dependent claim 7**, Meltzer et al. do not disclose processing a given file into XML compliant code. However, inasmuch as Meltzer et al. teach using XML documents (*e.g.*, Meltzer et al., col. 10, lines 22-45), it would have been obvious to one of ordinary skill in the art to process a given file into XML compliant code because one of ordinary skill would have recognized, as Meltzer et al. teach (col. 2, line 38), that XML enables documents to be easily understood between applications.

Further, Meltzer et al. teach translating the XML compliant code into the DOM. (Meltzer et al., col. 28, lines 8-23.)

Regarding **dependent claim 8**, Meltzer et al. teach that the DOM is a tree (Meltzer et al., col. 28, lines 8-15), and inherent in this teaching is that the tag would have been located at a given node.

Regarding **dependent claim 9**, Meltzer et al. teach that the tag is a marker for initiating invocation of a tag handler inasmuch as they teach turning XML documents, including tags, into events (Meltzer et al., col. 24, lines 54-59), which inherently means that tags were markers for initiating invocation of tag handlers.

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Regarding **dependent claim 11**, Meltzer et al. teach the tag handler performing an algorithmic reorganization of the DOM inasmuch as they teach reordering nodes, a process which inherently would have been governed by an algorithm. (Meltzer et al., col. 28, lines 17-18.)

Regarding **independent claim 14**, Meltzer et al. does not teach isolating a given task in an object having a method. However, it was well known in the art at the time of applicants' claimed invention that methods in objects were used for performing given tasks, and one of ordinary skill in the art would have recognized that a logical step in creating an application would have been to isolate a given task, or piece of functionality, in an object. Therefore, it would have been obvious to one of ordinary skill in the art to isolate a given task in an object having a method.

Further, the rejection of claim 1 above is fully incorporated herein.

Regarding **independent claim 15**, Meltzer et al. teach a computer program product. (Meltzer et al., col. 9, lines 9-28.)

Further, the rejection of claim 1 above is fully incorporated herein.

Regarding **dependent claim 16**, the rejection of claim 7 above is fully incorporated herein.

Regarding **independent claim 17**, Meltzer et al. teach a processor and a memory coupled to the processor for storing an object having a method for performing a given task. (Meltzer et al., col. 9, lines 9-28.)

Further, the rejection of claim 1 above is fully incorporated herein.

Regarding **dependent claim 20**, the rejection of claim 2 above is fully incorporated herein.

17. **Claims 3-5, 12-13, and 18-19** are rejected under 35 U.S.C. 103(a) as being unpatentable over Meltzer et al. and *Mastering Java Beans*, and further in view of U.S. Patent Number 6,212,640 B1 to Abdelnur et al., issued April 3, 2001, filed March 25, 1999. With respect to the rejection of each dependent claim below, the preceding rejection(s) of the relevant base claim(s) is incorporated therein.

Regarding **dependent claim 3**, Meltzer et al. and *Mastering Java Beans* do not teach that the executable code is a servlet. However, Abdelnur et al. teach using a servlet as an intermediary between an application and a resource server (Abdelnur et al., col. 8, lines 65-67), and also teach that the benefit of doing so is that such a use of a servlet allows enforcement of a security scheme. (Abdelnur et al., col. 8, lines 53-62.) Therefore, it would have been obvious to one of ordinary skill in the art to have the executable code be a servlet.

Regarding **dependent claim 4**, Meltzer et al., *Mastering Java Beans*, and Abdelnur et al. do not teach that the call is a line of code in a servlet. However, inasmuch as it would have been obvious to have the servlet embody the executable code, and the executable code contains the call, the call inherently could only have existed as a line of code in the servlet.

Regarding **dependent claim 5**, Meltzer et al. and *Mastering Java Beans* do not teach that access to the servlet is unrestricted and access to the object is restricted. However, as noted above regarding claim 3, Abdelnur et al. teach have a servlet with unrestricted access being able to call to an object to which access is restricted, and further teach that this arrangement allows

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enforcement of a security scheme. Therefore, it would have been obvious to one of ordinary skill in the art to have made access to the servlet unrestricted and access to the object restricted.

Regarding **independent claim 12**, Meltzer et al. do not teach in an offline process, generating an object having a method for performing a given task. However, *Mastering Java Beans* teaches Java Beans as objects that have methods for performing a given task on pages 43-44. Moreover, *Mastering Java Beans* teaches on pages 33-34 that Java Beans have the benefits of offering reusable functionality and being platform-independent. Therefore, it would have been obvious to one of ordinary skill in the art to have, in an offline process, generated Java Beans, *i.e.*, an object having a method for performing a given task.

Further, Meltzer et al. teaches generating a DOM tree representation of the page and replacing a custom tag in a DOM with a script and processing the DOM to generate executable code having a call that is generated as a result of the script inasmuch as Meltzer et al. teach that “XML logic structures are translated into JAVA objects which carry the data of the XML element as well as methods associated with the data such as get and set functions.” (Meltzer et al., col. 26, lines 27-30; *see also* col. 28, lines 11-13: “One preferred version of the tree builder 506 generates a document object model DOM object 507, according to the specification of the W3C”). Meltzer et al. and *Mastering Java Beans* do not teach that the executable code is a servlet, but this would have been obvious to one of ordinary skill in the art in view of Abdelnur et al. as noted above regarding claim 3.

Further, Meltzer et al. does not teach at request time having the call invoke the method in the custom tagbean but this step would have been obvious to one of ordinary skill in the art in

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view of the benefits of calling methods in Java Beans taught by *Mastering Java Beans* and discussed above.

Regarding **dependent claim 13**, the rejection of claim 7 above is fully incorporated herein.

Regarding **dependent claim 18**, the rejection of claim 3 above is fully incorporated herein.

Regarding **dependent claim 19**, Meltzer et al. do not teach compiling and class loading the Java servlet. However, Abdelnur et al. teaches that Java class are compiled into byte code (Abdelnur et al., col. 4, lines 55-57) and class loaded (Abdelnur et al., col. 5, lines 3-5) in order to be run. Therefore, it would have been obvious to one of ordinary skill in the art to have compiled and class loaded the Java servlet.

18. **Claim 10** is rejected under 35 U.S.C. 103(a) as being unpatentable over Meltzer et al. and *Mastering Java Beans* as applied to claim 9 above, and further in view of U.S. Patent Number 6,266,681 B1 to Guthrie, issued July 24, 2001, filed April 8, 1997.

Meltzer et al. and *Mastering Java Beans* do not teach the tag handler performing a macro substitution. However, Guthrie teaches a tag handler performing a macro substitution inasmuch as Guthrie teaches inserting code into an HTML document upon encountering a given tag. (Guthrie, col. 10, lines 52-67.) Guthrie further teaches the benefit of thereby allowing components to be added to markup language documents. (Guthrie, col. 3, lines 21-26.) Therefore, it would have been obvious to one of ordinary skill in the art to have had the tag handler perform a macro substitution.

Double Patenting

19. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

20. Claims 1-20 are provisionally rejected under the judicially created doctrine of double patenting over claims 1-20 of copending Application No. 09/409,372. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: parsing a document object model and inserting code into it based on identification of a tag, and then executing the code including a method call.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

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Conclusion

21. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent Number	Name	Issue Date	File Date	
6,456,308 B1	Agranat et al.	9/24/02	8/8/97	
6,380,561 B1	Allard et al.	4/9/02	4/5/99	
6,308,198 B1	Uhler et al.	10/23/01	11/30/98	
6,188,401	Peyer	2/13/01	3/25/98	


World Wide Web Consortium, *Document Object Model (DOM) Level 1 Specification Version 1.0*, W3C Recommendation 1 October 1998, pages 1-49.

22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles A. Bieneman whose telephone number is 703-305-8045. The examiner can normally be reached on Monday - Thursday, 7:00 a.m. - 5:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on 703-308-5186. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4700.

CAB
February 20, 2003


HEATHER R. HERNDON
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